REMARKS

Claims 1-3, 7-10, 13-15, 19-23, 25-29, 31, 32, and 34-36 are all the claims pending in the

application. By this Amendment, Applicants cancel claims 6 and 18 without prejudice or

disclaimer.

In addition, claims 1, 8, 27, and 28 have been amended to narrow the issues on appeal.

Applicants respectfully submit that the amendments do not require any further search or

consideration (e.g., claim 1 has been amended merely to delete the repeated word "the" in the

claim, claims 8 and 28 have been amended similar to previously presented claim 20, and claim

27 has been amended similar to previously presented claim 7). Accordingly, entry of the

amendments is respectfully requested.

Claim Rejections - 35 U.S.C. § 112

Claims 6, 8, 18, 27, and 28 are rejected under 35 U.S.C. § 112, first paragraph as

allegedly failing to comply with the enablement requirement. Applicants do not acquiesce to this

rejection. However, in order to expedite prosecution, claims 6 and 18 have been canceled

rendering the rejection thereto moot. Further, claims 8, 27, and 28 have been amended to

overcome the rejection.

Claim Rejections - 35 U.S.C. § 103

Claims 1-3, 6-10, 13-15, 18-23, 25-29, and 34-36 are rejected under 35 U.S.C. § 103(a)

as allegedly being unpatentable over U.S. Patent No. 6,282,711 to Halpern *et al.* ("Halpern") in

view of the Applicants' admitted prior art ("AAPA") and U.S. Patent No. 7,099,950 to Jones *et*

al. ("Jones"). For *at least* the following reasons, Applicants respectfully traverse the rejection.

Applicants respectfully submit that claim 1 is patentable over the proposed combination

of Halpern, the AAPA, and Jones. For example, amended claim 1 relates to a method of

requesting and processing a plurality of objects from a server. The method comprises, *inter alia*:

- **opening a session with at least one server**,
- *searching* in the at least one server for an information element based upon a search criteria *after the opening of the session with the at least one server*,
- receiving from at least one server search results displayable on a web page comprising a list identifying occurrences of the information element, wherein at least some of said occurrences of the information element identify objects,
- *generating* for at least two identified objects, requests to the at least one server for obtaining the at least two objects,
- *packing* the plurality of requests for the at least two objects into a packed request message and transmitting the packed request message to the at least one server,
- *receiving* a response message from the at least one server, the response message containing the at least two objects packed into the response message,
- **ending the session with the at least one server after the receiving the response message,**
- **automatically unpacking the at least two objects contained in the response message for displaying on the webpage.**

In the previous Amendment filed on October 16, 2007, Applicants submitted that the

combined teachings of Halpern and the AAPA do not teach or suggest that the searching,

receiving search results, generating, packing, and receiving the response message are all carried

out within a session opened with the at least one server (previous Amendment, pages 17-18).

In the current Office Action, the Examiner acknowledges that Halpern and the AAPA do

not disclose this feature. However, the Examiner asserts that Jones discloses a system in which a

client and a server exchange requests and responses, respectively, within a session (Office

Action, page 5, last paragraph). The Examiner further contends that it would have been obvious

for a skilled artisan to modify the server query system of Halpern and the AAPA to include the

session initiation and termination taught by Jones because "this allows the client to set up distinct

times to use the servers services and maintain the networked connection" (Office Action, page 6,

lines 3-8). Applicants respectfully disagree and submit that the Examiner is impermissibly using hindsight in view of the Applicants' own disclosure in an effort to render the claimed method unpatentable.

For instance, whether a <u>motivation</u> to combine prior art references has been demonstrated is a question of fact. *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1348 53 USPQ2d 1580, 1586 (Fed. Cir. 2000). To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present <u>a convincing line of reasoning</u> as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). Otherwise, the conclusion to be reached is that the motivation is predicated on hindsight.

In particular, there must be some showing of the obviousness of the claim as a whole, not the discrete parts to establish *prima facie* obviousness. The tests of whether to combine references needs to be applied rigorously. *See: In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999), *limited on other grounds by In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1769 (2000). The same principle applies here because the Examiner's analysis is backward to achieve the end point already defined – carrying out the claimed steps of searching, receiving search results, generating, packing, and receiving the response message all <u>within a single session</u>. The first, is that *prima facie* obviousness is a legal requirement and the burden is on the Examiner to demonstrate using only objective evidence or suggestion from the applied prior art and knowledge in the art, that one of ordinary skill would have been led to the claimed invention as a whole <u>without</u> recourse to Applicants' disclosure. See: *In re Oetiker*, 977

F.2d1443, 1447-48, 24USPQ2d 1443, 1446-47(Fed.Cir.1992); *In re Fine* 837 F.2d1071, 1074-

75, 5USPQ2d 1596, 1598-1600(Fed.Cir.1988).

As a matter of law then, it is the burden of the Examiner to demonstrate that the prior art,

and not Applicants' disclosure, would lead the skilled artisan to the claimed invention as a

whole. What the Examiner has done, and as plainly apparent in the statement of rejection, is to

dissect the claim into discrete components and then to apply individual pieces of prior art (*See*

Office Action, pages 5-6). That is the hallmark of hindsight and not the characteristic of

obviousness.

For example, the given reason for motivation to combine the teachings of Jones with

Halpern and the AAPA is, at best, inadequate. As noted above, the Examiner contends that a

person of ordinary skill in the art would modify the server query system of Halpern and the

AAPA to include the session initiation and termination taught by Jones because it would allow

the client to set up distinct times to use the servers services and maintain the networked

connection. However, this motivation of performing the steps set forth in claim 1 within a

session is only found in the Applicants disclosure.

Jones is directed to solving the problem of ad hoc syntaxes for specifying requests and

replies prevalent in legacy debugging tools related to ASCII protocols (Jones, col. 1, lines 16-

47). Jones recognizes that XML can be used to represent both the protocol layer and the

application data in a session-oriented protocol. However, it does even remotely suggest or relate

to the steps performed in claim 1 between the opening and ending of the session, e.g., searching

for an information element, generating requests for at least two objects which were included in

the search results for the information element, and thereafter automatically unpacking the at least

16

two objects contained in a response message from the server for <u>displaying</u> the objects on the

web page. Moreover, as the Examiner already admits, Halpern and the AAPA do not disclose or

suggest carrying out the above-noted features within a session.

As such, the Examiner's analysis is nothing more than a classic hindsight reconstruction

where the claimed invention is debased and trivialized because in retrospect, the Examiner can

find the disparate steps, uniquely combined, existing in individual basis in multiple prior art

references. Such a hindsight construction has been universally condemned. The Federal Circuit

has been unwavering in its condemnation of hindsight logic. Typical, is the decision in *Grain*

Processing Corp. v. American Maize-Products Co., 840 F.2d 902, 907(Fed.Cir.1988) wherein

Judge Mayer for the Federal Circuit stated,

> Care must be taken to avoid hindsight reconstruction using
> the patent in suit as a guide through the maze of prior art
> references combining the right references in the right way
> so as to achieve the result of the claims in suit.

More recently, Judge Clevenger speaking for the Court on the same issue in *McGinley v.*
Franklin Sports, Inc., 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) stated,

> The genius of invention is often a combination of known
> elements which in hindsight seems preordained. To prevent
> hindsight invalidation of patent claims, the law requires
> some "teaching, suggestion, or reason" to combine cited
> references.

Same here, there is no rhyme or reason why Halpern, the AAPA, and Jones would stand

out from the maze of prior art. Only the Applicants' disclosure (see page 3, line 16 to page 4,

line 18) identifies the high degree of overhead processing resulting from the setting up and

tearing down of multiple sessions, and the advantages of performing the above-noted claim

features within a single session.

In view of the foregoing, Applicants respectfully submit that the Examiner's reasoning to combine these references is based on impermissible hindsight. The Examiner's approach fails to heed the injunction for "guarding against falling victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher". *Id.* At 1008. Here, the Examiner's methodology is nothing more than what has been rejected as the clear application of hindsight. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 1.

Furthermore, even if one skilled in the art were to draw from the teachings of Jones, Applicants respectfully submit that this would still not render claim 1 unpatentable. In claim 1, the session ends after the response message is received. Thereafter, the at least two objects contained in the response message are automatically unpacked for displaying on the webpage. In Jones, there is no explicit disclosure or implicit suggestion as to what operations are carried out after the session is terminated between the server and the client. In fact, even based on a cursory review of FIGS. 2-4 of Jones, it appears that all the operations referencing and acting on the objects are carried out between the initiation and subsequent termination of the session (e.g., any operation on the objects, such as deletion thereof, is carried out within the session). As such, Jones teachings would actually lead a skilled artisan to unpack and display the objects within the session, contrary to the requirements of claim 1. The Examiner has not shown how the combined references teach ending the session after receiving the response, but before automatically unpacking and displaying the objects on a webpage. For *at least* these additional reasons, claim 1 is not unpatentable over the alleged combination of Halpern, the AAPA, and Jones.

Since claims 2-3, 7-10, 13-15, 19-23, 25-29, and 34-36 are also rejected based on the combined teachings of Halpern, the AAPA, and Jones, they are patentable for *at least* reasons similar to those given above with respect to claim 1.

Furthermore, with respect to independent claims 8, 20, and 28 the Examiner contends that Jones, in col. 11, lines 40-52, discloses that the response message comprises an indicator of a first order in which the packed objects are to be displayed, wherein <u>the first order is different from the order in which the plurality of the objects are automatically **packed**</u>. Applicants respectfully disagree and submit that the teachings of Jones are being misinterpreted in the Office Action.

The cited portion of Jones discloses asynchronous operations in its XML-based protocol. Here, instead of each response from the server being paired directly with the request initiated by the client ("with ordering preserved"), responses are returned in an order different from the order of the requests initiated by the client (Jones, col. 11, lines 37-44). As an initial matter, Applicants point out that Jones does not even disclose that any of these responses includes a plurality of the objects that are automatically **packed**. Furthermore, the order referred to in Jones is the order of discrete responses from the server which are transmitted in response to discrete requests from the client. Jones discloses that this order, i.e., <u>the order in which each of these individual responses is separately transmitted to the client, may be different from the order of the requests initiated by the client</u>. Jones does not even disclose any information regarding the order in which objects within a response message are packed, let alone disclose that the order in which the objects are displayed is different from the order in which the objects are packed. That is, Jones' ordering relates to the ordering of multiple response messages corresponding to

multiple requests, and not to the order of objects within a response message corresponding to a

request. On the other hand, the first and the second order recited in the claims relates to the

order of objects within a single response message.

Therefore, Applicants respectfully submit that claims 8, 20, and 28 are patentable over

any conceivable combination of Halpern, the AAPA, and Jones. Accordingly, Applicants

respectfully request the Examiner to withdraw the 35 U.S.C. § 103(a) rejection.

Claims 31 and 32 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable

over Halpern in view of U.S. Patent No. 6,075,943 to Feinman, and further in view of the AAPA.

For *at least* the following reasons, Applicants respectfully traverse the rejection.

Claim 31 relates to a method of transferring a plurality of objects from a server to a

client. The method comprises, *inter alia*, *receiving* a request from the client for the plurality of

objects, and *retrieving* from an object store a packed object having a plurality of objects

corresponding to the requested plurality of objects. The plurality of objects requested for by the

client are packed into the packed object prior to receiving the request for the plurality of objects.

The response message comprises an indicator of a predetermined order in which the packed

objects are to be presented. The Examiner contends that cols. 2, 3, and 5 of Feinman disclose the

above-noted features of claim 31. Applicants respectfully disagree.

For instance, the Examiner, citing col. 5, lines 49-55 of Feinman, contends that since the

automatic installations system builds a command for the remote submission, the command

(indication) containing the name of the appropriate decompression program to run specifies the

order to present the data (Office Action, page 27). However, as submitted on pages 19-21 of the

previous Amendment, even if the installation of application programs suggests displaying the

application programs, **the compressed file sent to the client in Feinman does not comprise the**

sequential file 100 which is used to identify a remote client's delivery points and delivery

timings. Since the sequential file 100 is not part of the compressed file sent to the client,

Feinman's compressed file does not include any indicator of an order, much less a

predetermined order, in which the application programs are to be installed. The Examiner

admits to this point in the Office Action since, as noted above, it is stated in the Office Action

that "the automatic installations system builds a <u>command</u> for the remote submission..." (Office

Action, page 27, emphasis added). <u>This command is not part of the compressed file sent to the</u>

<u>client</u>.

Furthermore, in the previous Amendment, it was submitted that Halpern does not disclose

or suggest that the requested plurality of objects are packed into the packed object <u>prior to</u>

<u>receiving the request for the plurality of objects</u>. In response, the Examiner now relies on col. 2,

lines 34-45 and col. 3, lines 1-25 of Feinman to disclose this feature (Office Action, page 30).

Applicants respectfully disagree.

Applicants note that Feinman is directed to a system and method for remotely

transferring and installing client server application programs from a source computer onto a

remote client within a data processing system <u>in an unattended mode</u> (*see* Feinman: Abstract,

col. 1, lines 43-59, and FIG. 1A, e.g., Feinman states that there is a need for an improved method

of installation, where the source machine remotely installs the application programs onto another

machine and <u>does not require manual interaction at each site</u>). That is, <u>there is no request at all</u>

<u>in Feinman</u>.

21

For instance, in step 12 of FIG. 1a of Feinman (which is the <u>first</u> step of Feinman's method), the automated installation system packages the one or more applications into a compressed file. This step is carried out <u>absent any request</u> for the compressed file from the destined remote client. Since there is no request prior to the packaging of the applications in Feinman, it cannot disclose that <u>the requested plurality of objects are packed into the packed object **prior to receiving the request for the plurality of objects**</u> as required by claim 31.

Halpern and the AAPA do not cure these deficient teachings of Feinman. Moreover, the teachings of Feinman would lead one skilled in the art away from the modified server <u>query</u> system of Halpern and the AAPA since Feinman's objective is to transmit the compressed filed to the client without any query or request at all.

Therefore, Applicants respectfully submit that Feinman alone, or in combination with Halpern and the AAPA, does not disclose or suggest the noted features of claim 31. Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection of claim 31.

Claim 32 is patentable *at least* by virtue of its dependency on claim 31.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue

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Respectfully submitted,

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